

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Zhong Dong et al		
Assignee:	ProMOS Tech. Inc.		
Title:	METHOD OF FORMING ONO-TYPE SIDEWALL WITH REDUCED BIRD'S BEAK		
Serial No.:	10/821,100	Filing Date:	April 7, 2004
Examiner:	Vu David	Group Art Unit:	2818
Docket No.:	M-15295 US	Confirmation No.:	8965

San Jose, California  
June 18, 2008

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**Rule 181 Petition Regarding Nonresponse by Examiner to  
Applicant's/Appellant's Reply Brief**

Dear Sir:

Applicant respectfully seeks redress from the Examiner's action or inaction of 4/16/2008 (copy attached as Exhibit A) in which the Examiner merely noted Appellant's Reply Brief (filed 3/20/2008) and let it move on to the Board of Appeals for decision without responding to the Reply Brief in detail. The relief sought is immediate remand to the Examiner to reply in accordance with Board of Appeals procedural requirements as detailed below.

**Timeliness**

This petition comes on the heels of a Board of Appeals decision dated 6-13-2008 which Appellant's representative recently noticed and is discussed below. Although 37 CFR 181(f) presumes as untimely any petition filed more than 2 months after the examiner's action

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(or inaction) complained of, it is respectfully submitted that this case warrants a waiver of that general rule because the Ex Parte Gammon opinion (decided 6-13-2008) is part of the basis for this petition and Applicant could not have reasonably argued at an earlier date with Gammon as a basis. Besides, to let an unripe appeal stew on the Board's docket without immediate redress would be a miscarriage of justice.

Should the PTO decide not to waive the general timeliness rule despite the above, Applicant requests a one month extension and provides authorization to charge the deposit account below.

### **Statement of Facts**

The case is on appeal before the USPTO Board of Appeals.

Applicant filed a Reply Brief on 3/20/2008 in response to the Examiner's Answer of 2/25/2008.

In that Reply Brief, on page 22, in a section entitled "(D.5) Reversible Error 3: Ignoring Rebuttal Evidence", Applicant/Appellant challenged the Examiner's characterization of the Rule 132 Declaration that had been filed during prosecution. This was an issue being raised for a first time because the Examiner had not previously characterized the Rule 132 declaration as such (e.g., as being an opinion declaration signed by an inventor --it is not signed by an inventor and it is not mere opinion). Applicant/Appellant immediately challenged the Examiner's characterization in the Reply brief. The Examiner has not responded at least with regard to challenge over this crucial point.

Recently, in another case (Ex Parte Gammon 6-13-2008) involving another Applicant's challenge to a crucial fact, the Board of Appeals ruled that the Examiner must respond by way of a Supplemental Answer and cannot leave it to the Board's speculation and conjecture as to what the Examiner's position is regarding the challenged crucial fact.

It is respectfully submitted that the present situation is at least the same if not more egregious than that of Ex Parte Gammon (cited and discussed below). The present case is unripe for decision by the Board because the Examiner has not clarified his position regarding challenged characterization of the Rule 132 Declaration. Accordingly, the case should be remanded immediately to the examiner for a Supplemental Answer rather than being allowed to marinate on the Board's docket with a possible prolonged extension of patent term due to PTO inaction.

**Ex Parte Gammon 6-13-2008 (copy attached as Exhibit B)**

In a case decision released to the public on 6-13-2008 (Appeal 2008-1420), the Board ruled:

"The Examiner, in the Answer, should have, but did not, then explicitly address this cursory cite to the declaration. In order to make the record clear, the Examiner should clarify whether he maintains the position he took in the Final rejection that the declaration is insufficient to overcome the 35 U.S.C. § 102(b) rejection. ORDER Accordingly, it is **ORDERED that the application is remanded to the Examiner: 1) for the Examiner to clarify the Examiner's position regarding the declaration** submitted by the Appellant as Appendix B to the Appeal Brief. 2) for such further action as may be appropriate."  
[*Emphasis added.*]

The above was in regard to what was termed a "cursory cite" to a declaration. In the present case, Appellant's Reply Brief made more than merely a cursory reference to the Rule 132 Declaration. It made numerous explicit references including an explicit challenge to the Examiner's characterization and summary dismissal of the Rule 132 Declaration. (Note again page 22, section D.5 of the Reply Brief.) Therefore in this case, even more so than in Ex Parte Gammon, an immediate remand is warranted with an order that the Examiner clarify his position regarding the Declaration and that the Examiner take such further action as may be appropriate.

**Ex Parte Gudas et al 5-22-2008 (copy attached as Exhibit C)**

In another case decision also recently released to the public on 5-22-2008 (Appeal 2007-4149) and dealing with appeal procedure, the Board ruled (bottom of page 3):

In the face of Appellants' express repudiation of any admitted prior art asserted by the Examiner, and the Examiner's reliance on this assertion as essential to his conclusion of obviousness, **the present appeal is not ripe for our decision.** Significantly, the Examiner did not respond to this argument of Appellants which does not appear in the principal Brief. **The Examiner only noted and entered the Reply Brief.**

... This Remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 C.F.R. 41.50(a)(2) applies if a Supplemental Examiner's Answer is written in response to this remand by the Board.

This application, by virtue of its special status, requires immediate action by the examiner. See MPEP ' 708.01(d). The Board of Patent Appeals and Interferences must be informed promptly of any action affecting the appeal in this case, including reopening of prosecution, allowance and/or abandonment of the application. REMANDED." [*Emphasis added.*]

The above Ex Parte Gudas case is also similar to the procedural issues of this case. As in Gudas, in this case the Examiner only noted and entered the Reply Brief. As in Gudas, also in this case Appellant had made an express repudiation in the Reply Brief and it was with regard to a crucial piece of evidence (the Rule 132 Declaration). Therefore in the interest of justice, this case should be remanded immediately for appropriate action in accordance with the above rulings in other similar cases rather than being allowed to languish on the Board's docket, only to be remanded at a later date for being unripe.

**Conclusion**

A remand is respectfully requested in light of the foregoing.

No fee or extension of time is believed due. However, the Commissioner is authorized to charge any fee deemed required for maintaining this filing of the Rule 181 Petition and to charge any underpayment or credit any overpayment to Deposit Account No.

50-2257 for any matter in connection with this filing, including any fee for extension of time as deemed necessary and/or any fee for additional claims or petitions as may be required.

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Typed or printed name of person signing this certificate:

Gideon Gimlan

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Respectfully submitted,



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